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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,419	10/01/2003	Hirotochi Adachi	MUR-022-USA-P	5125
27955	7590	05/01/2008		
TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER KENNEDY, SHARON E	
			ART UNIT	PAPER NUMBER
			1615	
			MAIL DATE	DELIVERY MODE
			05/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,419	Applicant(s) ADACHI ET AL.	
	Examiner Sharon E. Kennedy	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 17-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Sun et al., US 6,678,554. See the comments set forth in the previous office actions.

Claims 17-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Iga et al., US 6,322,550. See the comments set forth in the previous office actions.

Response to Arguments

Applicant's arguments filed November 18, 2005 have been fully considered but they are not persuasive. Applicant has amended the transitional phrase of the preamble from "comprising" to --consisting essentially of--. Applicant argues that this change eliminates the possibility of the prior art elements in the claims such as the additional semi-permeable membrane of the pH regulators. However, this interpretation is not correct. MPEP 2111.03, entitled "Transitional Phrases," provides clear guidelines for these types of amendments. Specifically, in order for the phrase "consisting essentially of" to have the meanings ascribed to it as argued by applicant, the specification must have provided a clear indication of the "basic and novel characteristics of the invention", and what would have constituted a "material change".

Of particular interest is the guidance set forth by *In re Herz*, 537 F.2d 549, 551-552, 190 USPQ 461, 463 (CCPA 1976), which is discussed at MPEP 2111.03. Specifically, the facts are directed to a prior art hydraulic fluid requiring a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. The court found that the claims did not exclude the prior art dispersant since appellant's specification indicated the claimed composition could contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention.

Thus, applicant's specification is examined for teachings of what "materially effects" the invention as required by the *In re Herz*. Evidence of this nature in the specification provides the proper interpretation of applicant's new claims as amended with the "consisting essentially of" transition phrase. In this regard, the examiner points out applicant's published paragraphs [0105] and [0109] of US 2004/0071765. Paragraph [0105] states that pH adjusting additives and buffers may be added. Paragraph [0109] indicates that semi-permeable membranes may be included throughout the electrophoretic patch.

In view that applicant's specification does not teach that these ingredients must be excluded, rather, it indicates that they may be added as necessary, then applicant's phrase "consisting essentially of" must be given the meaning and interpretations as required by the teachings in *In re Herz*. The phrase does not eliminate the ingredients set forth in the prior art. Accordingly, the rejection must be maintained.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon E. Kennedy whose telephone number is 571/272-4948. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on 571/272-8373.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sharon E. Kennedy/
Sharon E. Kennedy
Primary Examiner
Art Unit 1615